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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/991,379
Filing Date: November 15, 2001
Appellant(s): MASCAVAGE ET AL.

Irvin I. Branch
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 11, 2008 appealing from the Office action mailed March 18, 2008. **(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,899,980	WILF ET AL.	5-1999
5,826,241	STEIN ET AL.	10-1998

20020004783	PALTENGHE ET AL.	1-2002
5,758,126	DANIELS ET AL.	5-1998
6,102,287	MATYAS, JR.	8-2000

Applicant Admitted Prior Art

- 1) Appeal Brief dated January 18, 2005, page 4, l. 19; p. 8, l. 6;
- 2) Reply Brief dated July 27, 2005, p. 4, ll. 1-3.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. **Claims 1-7, 9-15 & 17-20 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Wilf et al (US Patent 5,899,980, hereafter Wilf) in view of Stein et al. (US Patent 5,826,241, assigned to PayPal, hereafter Stein), Paltenghe et al. (PreGrant Publication 2002/0004783 A1, hereafter Paltenghe), Daniels et al. (US Patent 5,758,126, hereafter Daniels), Matyas, Jr. (US Patent 6,102,287, hereafter Matyas), and Applicant Admitted Prior Art (hereafter AAPA).

Re. Claim 1, Wilf discloses a method for authorizing and checking out from an online purchase between a customer and a vendor site/merchant system, the method comprising steps of:

- from the funds transfer server, interacting with the customer's computer to receive a transaction amount (Wilf calls the "transaction amount" the "transaction sum".) through an interface and receive customer assent to the transaction amount. (The term "transaction detail" is an integral component of Wilf's preferred term "transaction data" for approval by the customer/user. Wilf uses this term throughout the reference. Examples are Col. 2, lines 30, 35, 37 and following throughout the reference. Wilf provides specific definition to the effect that a "transaction amount" is a component of this "transaction detail" as illustrated in the following locations: Col. 1, lines 27-28 and Col. 9, lines 24-29).

- receiving authorization from the customer for billing of the transaction sum, wherein the transaction sum corresponds to the online purchase; and notifying the vendor site of authorization (Col. 2, lines 3-15, 52 – Col. 3, line 12).

Wilf does not explicitly disclose

- at a funds transaction server, receiving transaction information from the vendor site, wherein the transaction information comprises a transaction amount;
- opening a pop-up window for the customer;
- from the funds transfer sever, interacting with the pop-up window to present a transaction amount in the pop-up window.

However, **Paltenghe** discloses at a funds transaction server (the wallet server), receiving transaction information from the vendor site, wherein the transaction information comprises a transaction amount (implicitly included in the invoice information (pp. 6-7, [0071], ll. 3-11, 12-15, 19-22, 29-31).

Also, **Stein** discloses the presenting of the transfer amount through an internet interface (Col. 7, l. 58 – Col. 8, l. 18). The ordinary practitioner of the art would have seen it as obvious at the time of Applicant's invention that a web browser window was a practical and popular interface for displaying this transaction data for the customer buyer's authorization or rejection of the payment by transfer. Stein also discloses the use of a debit for making payment for a transaction performed over the internet as payment for the internet purchase's transaction amount (Col. 10, l. 51).

Further, **Daniels** discloses a definition for pop-up windows as windows 'which open or "pop-up" when a display button is actuated' (Col. 13, ll. 58-60).

In addition, Matyas discloses the use of pop-up windows in order to achieve a task in a payment process (Col. 12, l. 41, 46-49).

Finally, **Applicant admits** in his argument that the term "pop-up window" was "notoriously well known" at the time of this parent application's filing date (Appeal Brief, January 18, 2005, page 4, l. 19; p. 8, l. 6). Applicant also admits in his Reply Brief received on July 27, 2005 that "pop-up window is synonymous with a new web browser window, automatically opened and viewable by the customer" (p. 4, ll. 1-3). This

argument is convincing as it records Applicant's admission of the "automatically opening a new web browser window for the customer" as Appellant admitted prior art (AAPA), since pop-up windows were an obvious and even ubiquitous automatic phenomenon experienced by millions of web browser users at the time of Applicant's invention. Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Appellant's invention to have combined the disclosure of **Wilf, Paltenghe, Stein, Daniels, Matyas and AAPA** to establish an automated purchasing method for authorizing an online purchase between a customer and a vendor site which includes efficient automated web based steps and user conveniences for validating the payment for an online transaction without exposing the customer's personal information by maintaining security, motivated by a desire to overcome the reluctance of some users to transmit credit card account information over the internet (Wilf, Col. 1, ll. 24-27).

Re. Claim 2, as discussed in the rejection of claim 1 above, Wilf discloses a method wherein the equivalent of a pop-up window points away from the vendor site by pointing to the transaction server (Col. 2, lines 26-34).

Re. Claim 3, Wilf and Stein disclose a method for authorizing and checking out from an online purchase between the customer and the vendor site comprising a step of receiving account information from the customer corresponding to an account authorized for the debit (Wilf, Col. 2, lines 34-47. See claim 1 re. the debit).

Re. Claim 4, Wilf, Daniels, Matyas and AAPA disclose a method for authorizing and checking out from an online purchase between the customer and the vendor site wherein the equivalent of a pop-up window (i.e. the automatic browser window per the rejection of claim 1 above) overlays an existing web browser window of the vendor site (Wilf, Col. 2, lines 3-5, 47-51).

Re. Claims 5, 13 & 19, Wilf, Daniels, Matyas and AAPA disclose a method for authorizing and checking out from an online purchase between the customer and the vendor site wherein the receiving transaction information step triggers the opening the equivalent of a pop-up window step (Wilf, Col. 2, lines 3-15. See claim 1 above re. pop-up window.).

Re. Claims 6, 14 & 20, Wilf discloses the method for authorizing and checking out from an online purchase between the customer and the vendor site further comprising a step of transferring payment to an account associated with the vendor site after authorization is received (Col. 7, lines 45-57).

Re. Claim 7, Wilf, Daniels, Matyas and AAPA disclose a step of presenting a message to the customer in the equivalent of a pop-up window indicating at least one of the following: that authorization was canceled by the customer; that authorization was rejected by a funds transfer system; and that authorization completed normally (Wilf, Col. 7, line 58 - Col. 9, line 20. See claim 1 above re. pop-up window).

Re. Claim 9, Wilf discloses a computer-readable medium having computer-executable instructions for performing the computer-implementable method for authorizing and checking out from an online purchase between the customer and the vendor site of claim 1 (Col. 1, line 63- Col. 2, line 3).

Re. Claim 10, Wilf, Stein, Daniels, Matyas and AAPA disclose a method for checking-out from an online purchase by a customer from a merchant system, the method comprising steps of:

- at a funds transfer system, receiving transaction information from the merchant system, wherein the transaction information includes a transaction amount and wherein the funds transfer system is located at a network location away from the merchant system (See the rejection of claim 1);
- opening a pop-up window that is viewable by the customer, wherein the pop-up window is formulated by the funds transfer system (See the rejection of claim 1);
- from the funds transfer system, interacting with the pop-up window to present a transaction amount in the pop-up window and receive customer assent to the transaction amount (See the rejection of claim 1).
- receiving authorization from the customer for the transaction amount, wherein the transaction amount corresponds to the online purchase (Wilf, Col. 2, lines 3-15, 52 – Col. 3, line 12); and

- notifying the merchant system of authorization (Wilf, Col. 2, lines 3-15, 52 – Col. 3, line 12).

Wilf does not explicitly disclose receiving authorization from the customer of a debit for the transaction amount, wherein the debit corresponds to the online purchase. However, **Stein** discloses the use of a debit for making payment for a transaction performed over the internet as payment for the internet purchase's transaction amount (Col. 10, l. 51).

Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to combine the art of **Wilf, Stein, Daniels, Matyas and AAPA** to establish an automated purchasing method for checking-out from an online purchase by a customer from a merchant system which includes efficient automated web based steps and user conveniences for validating the payment for an online transaction without exposing the customer's personal information by maintaining security, motivated by a desire to overcome the reluctance of some users to transmit credit card account information over the internet (Wilf, Col. 1, ll. 24-27).

Re. Claim 11, Wilf and Stein disclose a step of receiving account information from the customer corresponding to an account available for debits by the funds transfer system (Wilf, Col. 2, lines 34-47. See claim 1 re. the debit).

Re. Claim 12, Wilf, Daniels, Matyas and AAPA disclose a method wherein the pop-up window overlays an existing web browser window of a web site associated with the merchant system (The a pop-up window implicitly overlays the existing web browser window being viewed).

Re. Claim 13, Wilf, Daniels, Matyas and AAPA disclose a method wherein the receiving transaction information step triggers the opening of a pop-up window step (This triggering step is implicit to the way a pop-up window or automatically opening window is implicitly designed to work).

Re. Claim 14, Wilf discloses a comprising a step of transferring payment to an account associated with the merchant system after authorization is received (Col. 2, ll. 14-15).

Re. Claim 15, Wilf discloses a method comprising a step of presenting a message to the customer in another window indicating at least one of the following: that

authorization was canceled by the customer; that authorization was rejected by the funds transfer system; and that authorization completed normally. (Col. 7, line 58 - Col. 9, line 20.).

Re. Claim 17, Wilf discloses a method for checking-out from an online purchase by a customer from a merchant system, the method comprising steps of:

- at a funds transfer system that is located at a network location away from the merchant system, receiving account information from the customer (Col. 1, l. 61 – Col. 2, l. 51. See the rejection of claim 1. Further, the funds transfer system is obviously at a location away from the merchant system connected by the world wide web (col. 1, ll. 5-24, 44-49; col. 1, l. 61-col. 2, 3);
- from the funds transfer system, interacting with the pop-up window to present a transaction amount in the pop-up window and receive customer assent to the transaction amount (see the rejection of claim 1);
- receiving authorization from the customer for the transaction amount, wherein the transaction amount corresponds to the online purchase (Col. 2, ll. 32-47); and
- notifying the merchant system of authorization (Col. 2, lines 3-15, 52 – Col. 3, line 12).

Wilf does not explicitly disclose

- receiving account information from the customer corresponding to an account available for debits by the funds transfer system;
- receiving authorization from the customer of a debit for the transaction amount, wherein the debit corresponds to the online purchase.
- opening a pop-up window that is viewable by the customer, wherein the pop-up window is formulated by the funds transfer system (col. 2, ll. 3-51 - see the rejection of claim 1);

However, **Stein** discloses the use of a debit for making payment for a transaction performed over the internet (Col. 10, l. 51). This implicitly includes receiving account information from the customer corresponding to an account available for debits by the

funds transfer system; and receiving authorization from the customer of a debit for the transaction amount, wherein the debit corresponds to the online purchase.

Daniels and Matyas disclose the use of pop-up windows (see the rejection of claim 1).

Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to combine the art of **Wilf, Stein, Daniels, Matyas and AAPA** with well known art to establish an automated purchasing method which includes efficient automated web based steps and user conveniences for validating the payment for an online transaction without exposing the customer's personal information by maintaining security, motivated by a desire to overcome the reluctance of some users to transmit credit card account information over the internet (Wilf, Col. 1, ll. 24-27).

Re. Claim 18, Wilf, Daniels and Matyas and AAPA disclose a method wherein the account information is received through the pop-up window (Wilf, Col. 2, lines 3-15. See claim 1 above re. pop-up window.).

Re. Claim 19, Wilf discloses a method comprising a step of receiving transaction information from the merchant system (Col. 2, lines 3-15.).

Re. Claim 20, Wilf discloses method of transferring payment to an account associated with the merchant system after authorization is received (Col. 2, lines 3-15; Col. 7, lines 45-57).

2. Claims 8 & 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Wilf, Stein, Fung and AAPA in view of Kolling et al** (US Patent 5,920,847, hereafter Kolling).

Re. Claims 8 & 16, none of **Wilf, Stein, Daniels, Matyas and AAPA** explicitly disclose a method for authorizing and checking out from an online purchase between the customer and the vendor, wherein the notifying step comprises a step of determining that a notification message was not received by the vendor site within a predetermined time period. However, **Kolling** discloses a method for authorizing and checking out from an online purchase between the customer and the vendor site wherein the notifying step comprises a step of determining that a notification message was not received by the

vendor site within a predetermined time period (Col. 37, lines 2-8). It would have been obvious for an ordinary practitioner of the art at the time of applicant's invention to have combined the disclosure of **Wilf, Stein, Daniels, Matyas and AAPA** with the disclosure of **Kolling** to establish an automated purchasing method which included a time limit for notifying a vendor of payment approval for an automated transaction in order to protect a vendor from undue delay in verifying such a transaction while minimizing costs, maintaining certain controls and discretionary actions on behalf of the biller, and simplifying the process for all the parties (Kolling, Col. 10, ll. 25-62).

(10) Response to Argument

NOTE: Though reworded, Appellants essentially repeat arguments which have been addressed in the most recent final Office Action's Response to Arguments section.

GENERAL ARGUMENT: The Appellants maintain that the rejection of claims 1, 10 and 17 under 35 U.S.C. § 103(a) is improper because the record has not established a *prima facie* case of obviousness. Specifically, the record has not properly followed the Graham factors to arrive at a showing that

- * all claim elements exist in the prior art and
- * has not established the relevant skill necessary to determine that it would have been obvious to combine the references.
- * Moreover, there is no "clear articulation of the reasons(s) why the claimed invention would have been obvious," the "key to supporting any rejection under 35 U.S.C. 103," according to MPEP 2141. (p. 5, ll. 8-14).

Appellant argues claim 1 as exemplary ((p. 5, l. 19).

Supporting Arguments:

A. The cited references "do not teach or suggest "from the funds transfer sever, interacting with the pop-up window to present a transaction amount in the pop-up window and receiving customer assent to the transaction amount." (p. 6, ll. 8-11; p. 6, ll. 8-27).

B. "The record has not identified the level of skill in the relevant art." (p. 7, l. 1; p. 7, ll. 1-19).

C. "..., claims 12 and 13 are believed to be allowable because the final Office Action states that the limitations are "implicit," which they are not. Claim 12 recites "wherein the pop-up window overlays an existing web browser window of a web site associated with the merchant system," but all pop-up windows *do not* necessarily overlay an existing web browser window." (p. 7, ll. 21-25; p. 7, ll. 21-29).

RESPONSE:

A. Appellant asserts that **Stein** was the sole reference and rationale used by the examiner in the final rejection of the limitation "from the funds transfer sever, interacting with the pop-up window to present a transaction amount in the pop-up window and receiving customer assent to the transaction amount." This assertion is out of the context in which claim 1 was rejected. Claim 1 has been rejected as being unpatentable over **Wilf** in view of **Stein, Paltenghe, Daniels, Matyas** and **AAPA**.

1. The major part of the first limitation which is being argued here is rejected over **Wilf** as follows: "from the funds transfer server, interacting with the customer's computer to receive a transaction amount through an interface and receive customer assent to the transaction amount." Appellant does not argue this rejection. (p. 2, ll. 19-27).

2. The rejection of claim 1 then states on p. 3, ll. 4-5 that the totality of the first limitation is not taught by **Wilf**. Yet, in context, this means that **Wilf** only fails to teach the pop-up window interface aspect while teaching the broader "customer's computer" interface.

3. The remainder of the rejection of claim 1 on p. 3, l. 11 through p. 4, l. 9 cites three references with extensive rationale to show the prior art of **Daniels, Matyas** and **AAPA** using the pop-up window even in the analogous art of a payment process (Matyas), and then concludes with a standard obviousness rationale for combining the references in rejecting claim 1, ending with a motivation statement from **Wilf**. **Daniels** is used for his disclosure of a definition of pop-up windows (p. 3, ll. 20-21). **AAPA** (Applicant/Appellant Admitted Prior Art) is used for their admissions regarding pop-up windows ("Finally, Applicant admits in his argument that the term "pop-up window" was "notoriously well known" at the time of this parent application's filing date (Appeal Brief, page 4, l. 19; p. 8, l. 6). Applicant also admits in his Reply Brief received on July 27, 2005 that "pop-up window is synonymous with a new web browser window, automatically opened and

viewable by the customer" (p. 4, ll. 1-3). This argument is convincing as it records Applicant's admission of the "automatically opening a new web browser window for the customer" as Appellant admitted prior art (AAPA), since pop-up windows were an obvious and even ubiquitous automatic phenomenon experienced by millions of web browser users at the time of Applicant's invention." – p. 3, l. 22 – p. 4, l.1. PLEASE NOTE: This refers to Appellant's original Appeal Brief dated January 18, 2005, which was later withdrawn.).

4. The **Stein** reference which Appellants base their argument on is used in a very narrow way in building the *prima facie* case of obviousness for two of the three limitations which are said to not "explicitly" be disclosed by Wilf. These two partial limitations are

- * "opening a pop-up window for the customer"; and
- * "from the funds transfer sever, interacting with the pop-up window to present a transaction amount in the pop-up window".

The pop-up feature aspects in both of these limitations in the claim rejection is discussed above.

Stein is only used to establish a narrow component of the argued limitation, as follows: "Also, Stein discloses the presenting of the transfer amount through an internet interface (Col. 7, l. 58 – Col. 8, l. 18). The ordinary practitioner of the art would have seen it as obvious at the time of Applicant's invention that a web browser window was a practical and popular interface for displaying this transaction data for the customer buyer's authorization or rejection of the payment by transfer. Stein also discloses the use of a debit for making payment for a transaction performed over the internet as payment for the internet purchase's transaction amount (Col. 10, l. 51)." (p. 3, ll. 11-17).

5. The remaining reference, **Paltenghe**, is used to reject another narrow limitation which Appellant is not arguing (p. 3, ll. 7-10).

CONCLUSION: The examiner has thoroughly and properly provided specific evidence and related rationale to that the cited references do teach and suggest the limitation "from the funds transfer sever, interacting with the pop-up window to present a

transaction amount in the pop-up window and receiving customer assent to the transaction amount" .

B. Regarding properly identifying the level of skill in the relevant art:

1. THE MATTER OF LAW:

The Supreme Court's decision in *KSR International Co. v. Teleflex Inc. (KSR)* cited the following excerpt from the MPEP:

a) "The question regarding explicit statements of the level of ordinary skill is addressed at MPEP 2141.03(II):

**SPECIFYING A PARTICULAR LEVEL OF SKILL IS NOT NECESSARY
WHERE THE PRIOR ART ITSELF REFLECTS AN APPROPRIATE LEVEL**

If the only facts of record pertaining to the level of skill in the art are found within the prior art of record, the court has held that an invention may be held to have been obvious without a specific finding of a particular level of skill where the prior art itself reflects an appropriate level. *Chore-Time Equip., Inc. v. Cumberland Corp.*, 713 F.2d 774, 218 USPQ 673 (Fed. Cir. 1983). See also *Okajima v. Bourdeau*, 261 F.3d 1350, 1355, 59 USPQ2d 1795, 1797 (Fed. Cir. 2001)."

b) "The Board of Patent Appeals and Interferences (Board) has also taken the position that the level of ordinary skill can be implicit in the record. *Ex parte Jud*, 85 USPQ2d 1280, 2006 WL 4080053 (Bd. Pat. App. & Interf. 2007)". "Commenting further about the role of the references, the Board stated:

Prior art references are cited precisely because they show what those skilled in the art would have known and been able to do before the effective filing date for the application. When used in combination, prior art references may even reveal a continuum of knowledge and ability greater than the sum of their separate, express disclosures.

Id. at 1282-83, 2006 WL 4080053 at *1. "

c) "If an attorney argues in response to an Office action that an examiner has failed to present a *prima facie* case of obviousness, and the argument is based solely on the bare observation that the examiner's rejection did not include an explicit factual finding as to the level of ordinary skill in the art, the examiner should find that the argument is not persuasive. The examiner should maintain the rejection if it is not otherwise overcome. In this instance, mere attorney argument as to the level of ordinary skill does not preclude making a second action final. On the other hand, if the level of ordinary skill was unresolved in view of the record, and if the issue was not

Art Unit: 3691

addressed by the examiner in the initial statement of the rejection, then in order to maintain the rejection the examiner must explicitly address and resolve the level of ordinary skill; in this situation the next action should not be made final. "

2. IN THE INSTANT CASE, as referred to in response A above, Appellant has already admitted on the record during the prosecution of this application that it was well known in the art to make use of pop-up windows. Further, the examiner has provided detailed evidence that every aspect of claim 1 was known in the art, which primarily involves the computer art and the internet, and has provided a motivation for combining references from one of the references. Accordingly, the examiner believes that he has properly identified the level of ordinary skill in the art involving independent claim 1, and by inference, independent claims 10 and 17.

C. Re. the argument re. claims 12 and 13 that the limitations are not "implicit" because they are not necessarily present in all circumstances.

This argument is directed at an anticipation rejection, which is not the case in the rejection of claims 12 and 13.

This argument is repeated virtually exactly from Appellant's pre-final Remarks. The examiner's response is repeated here from the most recent Office Action:

1. THE MATTER OF LAW:

MPEP 2144 **Supporting a Rejection Under 35 U.S.C. 103 [R-6]

>I. < RATIONALE MAY BE IN A REFERENCE, OR REASONED FROM COMMON KNOWLEDGE IN THE ART, SCIENTIFIC PRINCIPLES, ART-RECOGNIZED EQUIVALENTS, OR LEGAL PRECEDENT

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (setting forth test for implicit teachings); *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985) (examiner must present convincing line of reasoning supporting rejection); and *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

(The word "IMPLICIT" in the above paragraph excerpted from the MPEP has been UNDERLINED and made **BOLD** by the examiner for Applicant's convenience).

2. IN THE INSTANT CASE, the above court opinions establish the examiner's proper use of the word "implicit" in the obviousness rejections of claims 12 and 13. This demonstrates that implicitness is distinct from inherency and that the "inherency" analysis implied by Appellant is not appropriate.

CONCLUSION: The examiner believes that he has presented a proper *prima facie* case of obviousness in rejecting independent claims 1, 10 and 17 and dependent claims 12 and 13.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Respectfully submitted,

Siegfried E. Chencinski, /Siegfried E. Chencinski/

Examiner, Art Unit 3691

/Alexander Kalinowski/

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